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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,607	01/14/2002	Andrew C. Gilbert	01-1034 CF734	5741
63710 7590 02/28/2008 DEAN P. ALDERUCCI CANTOR FITZGERALD, L.P. 110 EAST 59TH STREET (6TH FLOOR) NEW YORK, NY 10022				
EXAMINER				
TINKLER, MURIEL S				
ART UNIT		PAPER NUMBER		
3691				
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02/28/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/047,607

**Applicant(s)**

GILBERT ET AL.

**Examiner**

MURIEL TINKLER

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date 11/14/2007
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This application has been reviewed. Claims 1-41 are pending. The rejection(s) are as follows.

#### ***Response to Arguments***

1. Applicant's arguments filed November 9, 2007 have been fully considered but they are not persuasive. The Applicant argues the following points: the Examiner has no grounds to conclude that Ginsberg was not owned by eSpeed; the Office Action does not make an element-by-element comparison between any claim and Silverman '583; and, the Examiner points to the 'disclosure of the Invention to reject a claim.
2. With respect to the Applicant's argument that the Examiner has no grounds to conclude that Ginsberg was not owned by eSpeed: the Applicant should submit a terminal disclaimer to overcome a Double Patenting rejection.
3. With respect to the Applicant's argument that the Office Action does not make an element-by-element comparison between any claim and Silverman '583, the Examiner disagrees.
4. With respect to the Applicant's argument that the Examiner points to the 'disclosure of the Invention to reject a claim, the Examiner could not find a claim that was rejected using only 'the Disclosure of the Invention' and the Applicant has not pointed out which claim or which page in the Office Action they are referring to for this argument.

***Response to Amendment***

5. The amendment filed November 9, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: computer data signals conveying two passive orders to be mediated with assistance of the computer system (there is no indication in the database of two passive orders being used or that these two orders are mediated with assistance of the computer system) ; a database indicating that a first/second of the two passive orders is entered (the specification indicates that the database is designed to indicate which participants utilize a principal/broker relationship and what limitations are placed on the activity, see pages 3-4); and, electronically determining the presentation of the first/second passive order (there is no mention in the specification of the determining the presentation of a first/second order). Based on the discussions above claims 6 and 14 will be rejected due to lack of support in the specification.
6. Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claims 6, 7, 14, 15 and 17-41 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The added material which is not supported by the original disclosure is as follows: computer data signals conveying two passive orders to be mediated with assistance of the computer system; a database indicating that a first/second of the two passive orders is entered; and, electronically determining the presentation of the first/second passive order which are critical or essential to the practice of the invention, is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The above elements are considered new matter because they are elements represented in the independent claims 6 and 14 and are not supported in the specification.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverman et al. (US 6,625,583 B1) hereafter referred to as Silverman '583.

12. Claims 1 and 9 discuss a system and method for presenting a trading interface, comprising: receiving a first passive trading command from a broker workstation; receiving a second passive trading command from a principal workstation; displaying the first passive trading command and the second passive trading command using a special designation, which indicates bid availability on a trader workstation. Silverman '583 discloses the information in Claims 1 and 9. Specifically Silverman '583 discloses: the use of a broker in column 1 (lines 20-26); the use of a principle workstation or trading booth in column 1 (lines 27-40); sending and receiving passive trading commands in figure 1; displaying passive trading commands using use tabs in column 4 (lines 11-42).

13. Claims 2 and 10 discuss the system and method of claims 1 and 9, wherein the displaying of the first trading command and the second trading command comprises displaying the first passive trading command in a different manner from the second passive trading command wherein the different manner is using different colors, using different fonts, using flashing or hiding an unavailable passive trading command.

Silverman '583 discloses the information in Claims 1, 2, 9 and 10. See the rejection(s) of Claims 1 and 9 above. Specifically Silverman '583 discloses displaying the first and

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second passive commands in a different manner in the Summary of the Invention in column 2 (lines 25-53).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3-5, 8, 11-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman '583 and Silverman et al. (US 5,136,501 A) hereafter referred to as Silverman '501.

16. Claims 3-5, 8 and 11-13 discuss a system and method for trading, comprising: trader; receiving a trading command from a first determining whether the first trader is acting as a broker; trader; and presenting the trading command to a second preventing the second trader from acting on the trading command when the first trader is acting as a broker so that the trading command does not form part of the trade and blocking the completion of the transaction. Silverman '583 discloses the information in Claims 3-5, 8 and 11-13. See the rejection(s) of Claims 1 and 9 above. Silverman '583 does not disclose the act of preventing a trader from acting on a trade. Silverman '501 teaches the art of preventing a trader from acting on a trade in the Abstract, column 3 (lines 18-38), column 4 (line 27) through column 5 (line 35) and column 17 (line 59) through column 18 (line 9). Therefore, it would have been obvious to a person having ordinary

skill in the art at the time the invention was made to modify Silverman '583 to gain the ability to block trade because, according to Silverman '501 in Disclosure of the Invention, to controllably mask the available trading market and efficiently transmit only the required matching information to those key stations which require it.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 6:30 AM until 3 PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T./

Examiner, Art Unit 3691

/Hani M. Kazimi/

Primary Examiner, Art Unit 3691